

REMARKS

I. Introduction

In response to the final Office Action dated December 18, 2008, Applicants have amended claim 1 to further clarify the subject matter of the present disclosure. Support for the amendment to claim 1 may be found, for example, in paragraph [0021] on page 11 of the specification. Claims 5 and 7 have been amended to correct improper antecedent basis and to clarify the claims. No new matter has been added.

A Request for Continued Examination (RCE) is being filed concurrently with this amendment.

For the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the cited prior art references.

II. The Rejection of Claims 1, 2 And 4-7 Under 35 U.S.C. § 103

Claims 1, 2 and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ogino et al. (USP No 4,678,598), Niemiec et al. (USP No. 6,495,498), or Wetzel (USP No. 4,885,107), all in view of Watson et al. (USP No. 4,136,163); and claims 5-7 are rejected as being unpatentable over Ogino, Niemiec, Wetzel, Watson and in further view of Shiroyama et al. (USP No. 6,328,982). Applicants respectfully submit that Ogino, Niemiec, Wetzel, Watson and Shiroyama fail to render the pending claims obvious for at least the following reasons.

With regard to the present disclosure, amended claim 1 recites a shampoo or body detergent composition comprising following components (A), (B), (C) and (D); (A) one or more cool and refreshing feeling substances selected from the group which consists of menthol,

menthone, camphor, pulegol, isopulegol, cineol, Japanese peppermint oil, peppermint oil, spearmint oil, and eucalyptus oil, (B) one or more cool feeling substances selected from the N-substituted-p-menthane-3-carboxamide derivatives represented by the following general formula (I); wherein R represents an alkyl group or alkenyl group having 1 to 10 carbon atoms, (C) one or more components selected from anionic surfactants, and (D) one or more components selected from water-soluble high-molecular-weight polymers and/or polyhydric alcohols, and wherein the ratio of the cool and refreshing feeling substance of the component (A) to the cool feeling substance of the component (B) is (70:30) to (99:1) by weight.

One feature of amended claim 1 is that the ratio of components A:B is in a range from 70:30 to 99:1 by weight. For example, as is shown in the specification in paragraph [0021] on page 11, the claimed ratio provides a shampoo or body detergent composition which has low controlled stimulus of the cool and refreshing feeling substance, an excellent cool and refreshing feeling effect and a long-lasting cool and refreshing feeling when applied to the hair or skin.

In contrast, none of the cited prior art references discloses the claimed range of components A and B. Ogino discloses a shampoo composition comprising 5 to 30% of surfactant, 0.05 to 5 wt% of aromatic chemicals such as menthol or camphor, and modified cyclodextrin.

Niemiec discloses a two-in-one detergent composition comprising a water-soluble silicone agent, cationic chemicals and a detergent. The only mention of adding menthol is discussed in col. 15, line 20 in which no amounts or concentrations are given. However, it is clear that the amount is not significant compared to the other components.

Wetzel and Watson both fail to disclose addition of menthol. Moreover, Shiroyama discloses a cool feeling composition having a good cool feeling effect obtained by adding vanillyl butyl ether to one of l-menthol, l-isopulego, 3-(1-menthoxy)propane-1,2-diol, and paramenthane-3,8-diol.

Thus, Ogino, Niemiec, Shiroyama and Wetzel describe only the compositions blending menthol, but fail to describe the use of N-substituted-p-menthane-3-carboxamides. This is admitted in the Office Action. It is alleged that Watson remedies this deficiency. However, as previously shown, Watson not only does not use menthol in combination with N-substituted-p-menthane-3-carboxamides, but Watson *teaches against* such a combination. Watson teaches menthol has disadvantages such as strong odor and relative volatility. For example, Watson states in col. 2, lines 3-12 “it is an object of the present invention to provide other compounds having pronounced cooling effect, in many cases far more persistent than that obtained with menthol, without the attendant disadvantages of a strong odor.”

It is alleged that the above argument that Watson teaches away from the use of menthol due to its strong odor “only provides stronger motivation to combine menthol with other substances to lessen the odor.” The Examiner is suggesting that because Watson DISCREDITS the use of menthol, it actually supports the use of menthol. This reasoning belies credibility. Moreover, the argument has no merit, precisely because Watson states that menthol is “*replaced*” by the N-substituted-p-menthane-3-carboxamides, not “added to” or “combined with”. It appears that the Examiner is attempting to rewrite the prior art to say what he wishes to support his argument, rather than stating what the prior art actually says.

In addition, the Examiner suggests that the teachings of Ogino, Neimiec, Wetzel combined with Watson would suggest a 1:1 ratio of component (A) and (B). However, the Examiner offers no evidence to support this allegation. In fact, since the two components are not combined in any of the cited prior art references, there can be no support for this. Moreover, even if this statement were true, the amendment to claim 1 requires a ratio of component A to B to be 70:30 to 99:1. As such, the Examiner's rejection is again, improper.

Moreover, the Examiner alleges that the examples provided in the specification to show superior results are not commensurate in scope with the instant claims, because only one element from each group of components (A), (B), (C), and (D) is provided. Applicants disagree with the Examiner's argument because the examples provided in the specification discuss precisely what the cited prior art references disclose, and directly compare the combination of (A) and (B) of the prior art. Furthermore, even though an example for each possible compound of claim 1 is not provided, each of the compounds in claim 1 is supported by the specification. As such, the Examiner's argument fails to rebuke the showing of superior results of the present specification.

In order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. As is clearly shown, Watson, Ogino, Neimiec, Wetzel and Shiroyama do not disclose a shampoo or body detergent composition comprising (A) a cool and refreshing feeling substance such as menthol, and (B) cool feeling substance composed of N-substituted-p-menthane carboxamide, wherein the ratio of component (A) to component (B) is from 70:30 to 99:1, by weight. As such, Watson, Ogino, Neimiec, Wetzel and Shiroyama fail to render amended claim 1 obvious and accordingly, claim 1 is patentable. Accordingly, Applicants respectfully request that the § 103(a) rejection of claim 1 be withdrawn.

III. All Dependent Claims Are Allowable Because The Independent Claim From Which They Depend Is Allowable

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims. *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 1 is patentable for the reasons set forth above, it is respectfully submitted that all pending dependent claims are also in condition for allowance.

IV. Conclusion

Having responded to all open issues set forth in the Office Action, it is respectfully submitted that all claims are in condition for allowance.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Nathaniel D. McQueen
Registration No. 53,308

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 NDM:MWE
Facsimile: 202.756.8087
Date: April 20, 2009

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